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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,065	08/24/2000	Wendy Hufford	GES-0005	2863
23413	7590	10/22/2003	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/645,065

Applicant(s)

HUFFORD, WENDY

Examin r

Natalie A. Pass

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the c rresp ndence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Notice to Applicant***

1. This communication is in response to the amendments filed 30 July 2003. Claims 1, 7, 10, 13-16 have been amended. Claims 5-6, 9, 11-12, and 17-18 have been previously amended. Claim 19 has been newly added. Claims 1-19 remain pending.

***Specification***

2. The objection to the abstract of the disclosure because of undue length is hereby withdrawn due to the amendment filed 30 July 2003.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The rejection of claims 14-16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention still stands.

(A) Claims 14-16 have been amended to recite, "the computer network of claim 13 wherein in said method ..." on line 1 of each claim. The language of claims 14-16 continues to make it unclear into which statutory category these claims fit – a computer network or a method.

***Claim Rejections - 35 USC §101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

6. Claims 1-4, 6, 13 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

(A) The amendments to claims 1-4, 6, 13 have not altered the basis for the rejection given in the previous Office Action (paper number 6, section 6, pages 3-4).

(B) Newly added claim 19 adds new limitations to independent claim 1, but the claim language in newly added claim 19 does not direct this claim to statutory subject matter for the same reasons as analyzed and discussed in the rejection of claims 1-4, 6, 13 in the previous Office Action (paper number 6), and incorporated herein.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-8, 10-15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al, U.S. Patent Number 5, 875, 431 in view of CPR Institute for Dispute Resolution Online Seminar Special Supplement Publication, November 1998, URL: <http://www.disputes.net/cyberweek2001/cpr11.98.pdf>, hereinafter known as CPR, and further in view of Martin, U.S. Patent Number 6, 330, 547.

(A) Claim 1 has been amended to include the recitation of:

"[...] based on a risk level of said potential litigation issues [...]" at lines 8-9;

"[...] as a communication from a legal department to at least one recipient [...]" at lines 10-11;

"[...] based on said risk level of said potential litigation issues, said risk level for said report being lower than said risk level for said alert [...]" at lines 12-14; and

"[...] as a communication from said legal department to at least one recipient [...]" at lines 15-16;

As per these new limitations, Heckman and CPR teach a method of early warning of potential litigation, within an entity as analyzed and disclosed in the previous Office Action (paper number 6) including

determining whether a report or "pop-up" (reads on an alert) is appropriate by performing an analysis (Heckman; column 25, lines 16-29);

issuing an alert or report "[...]" as a communication from a legal department to at least one recipient [...]" (Heckman; column 14, line 40 to column 16, line 12, column 25, lines 16-60).

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Heckman and CPR fail to explicitly disclose

"determining [...] based on a risk level of said potential litigation issues [...]".

However, the above features are well-known in the art, as evidenced by Martin.

In particular, Martin teaches determining a course of action "[...] based on a risk level of said potential litigation issues [...]" (Martin; Figure 5, Items 550 and 570, column 9, lines 45-60, column 10, lines 21-27, column 12, lines 49-63, column 15, lines 10-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of early warning of potential litigation, within an entity, of Heckman and CPR, to include determining a course of action based on a risk level of said potential litigation issues, as taught by Martin, with the motivations of establishing predictive models to provide adequate risk management analysis, reducing exposure to litigation and the risk of loss such as litigation loss in the case of unforeseen events (Martin; column 1, lines 56-61, column 2, lines 28-33).

Heckman and CPR fail to explicitly disclose

"determining [...] based on said risk level of said potential litigation issues, said risk level for said report being lower than said risk level for said alert [...]".

However, the above features are suggested by the combination of the above prior art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a determination of type of notice based on risk level of potential litigation in order to deliver the appropriate warning or legal notification to enable the appropriate course of action as required by the urgency or scope of the situation (Heckman; see at least column 7, line 14 to column 8, line 4, column 11, lines 17-40, 47-61, column 13, line 58 to column 14, line 9, column

20, lines 35-61, column 22, lines 12-65), with the motivation of associating the scope of legal action demanded with the type of notice delivered (Heckman; column 7, line 14 to column 8, line 4).

The motivations for combining the respective teachings of Heckman and CPR are as given in the rejection of claim 1 in the prior Office Action (paper number 6) and incorporated herein.

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 6, section 8, pages 5-6), and incorporated herein.

(B) Claim 7 has been amended to include the recitation of:

"[...] based on a risk level of said potential litigation issues [...]" at line 16; and

"[...] based on a risk level of said potential litigation issues [...] said risk level for said report being lower than said risk level for said alert " at lines 21-22.

As per these new limitations, claim 7 recites an article of manufacture rather than a method. As the elements features of method claim 1 have been shown to be either disclosed by or obvious in view of the collective teachings of Heckman, CPR, Martin, it is readily apparent that the article of manufacture disclosed by the applied prior art performs the recited underlying functions. As such, these limitations recited in claim 7 are rejected for the same reasons given above for method claim 1.

The motivations for combining the respective teachings of Heckman, CPR, Martin are as given in the rejection of claim 1 above, and incorporated herein and in the prior Office Action (paper number 6) and also incorporated herein.

The remainder of claim 7 is rejected for the same reasons given in the prior Office Action (paper number 6, section 8, pages 8-10), and incorporated herein.

(C) Claim 10 has been amended to include the recitation of:

"[...] based on a risk level of said potential litigation issues [...]" at line 16; and

"[...] based on said risk level of said potential litigation issues [...] said risk level for said report being lower than said risk level for said alert " at lines 21-22.

As per these new limitations, claim 10 recites a computer program product rather than a method. As the elements features of method claim 1 have been shown to be either disclosed by or obvious in view of the collective teachings of Heckman, CPR, Martin, it is readily apparent that the computer program product disclosed by the applied prior art performs the recited underlying functions. As such, these limitations recited in claim 10 are rejected for the same reasons given above for method claim 1.

The motivations for combining the respective teachings of Heckman, CPR, Martin are as given in the rejection of claim 1 above, and incorporated herein and in the prior Office Action (paper number 6) and also incorporated herein.

The remainder of claim 10 is rejected for the same reasons given in the prior Office Action (paper number 6, section 8, pages 11-13), and incorporated herein.

(D) Claim 13 has been amended to include the recitation of:

"[...] based on a risk level of said potential litigation issues [...]" at lines 11-12;



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"[...] as a communication from said legal department to at least one recipient [...]" at lines 13-14;

"[...] based on said risk level of said potential litigation issues, said risk level for said report being lower than said risk level for said alert " at lines 16-17; and

"[...] as a communication from said legal department to at least one recipient [...]" at lines 18-19;

As per these new limitations, claim 13 recites a method that includes a computer network rather than a method with no network recited. As the elements features of method claim 1 have been shown to be either disclosed by or obvious in view of the collective teachings of Heckman, CPR, Martin, it is readily apparent that the method in a computer network disclosed by the applied prior art performs the recited underlying functions. As such, these limitations recited in claim 13 are rejected for the same reasons given above for method claim 1.

The motivations for combining the respective teachings of Heckman, CPR, Martin are as given in the rejection of claim 1 above, and incorporated herein and in the prior Office Action (paper number 6) and also incorporated herein.

The remainder of claim 13 is rejected for the same reasons given in the prior Office Action (paper number 6, section 8, pages 13-15), and incorporated herein.

(E) Claims 2-3, 5-6, 8, 11-12, 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 8, pages 5-15), and incorporated herein.

(F) The amendments to claims 14-15 appear to have been made merely to correct minor typographical or grammatical errors rendering the claims indefinite. While these changes attempt to render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 6, section 8, pages 13-15), and incorporated herein.

9. Claims 4, 9, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al, U.S. Patent Number 5, 875, 431 and CPR Institute for Dispute Resolution Online Seminar Special Supplement Publication, November 1998, URL: <http://www.disputes.net/cyberweek2001/cpr11.98.pdf>, hereinafter known as CPR, and Martin, U.S. Patent Number 6, 330, 547 as applied to claims 1, 7, 10, and 13 above, and further in view of Child Welfare and the Professional report, September 1999, URL: <http://www.chesco.org/pdf/manrepbook.pdf>, hereinafter known as CWP for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 4, 9, and 18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 9, pages 15-16), and incorporated herein.

(B) The amendments to claim 16 appear to have been made merely to correct minor typographical or grammatical errors rendering the claims indefinite. While these changes attempt to render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 6, section 9, pages 15-16), and incorporated herein.

10. Newly added claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al, U.S. Patent Number 5, 875, 431 in view of CPR Institute for Dispute Resolution Online Seminar Special Supplement Publication, November 1998, URL: <http://www.disputes.net/cyberweek2001/cpr11.98.pdf>, hereinafter known as CPR, and further in view of Martin, U.S. Patent Number 6, 330, 547.

(A) As per newly added claim 19, Heckman, CPR, Martin, teach a method as analyzed and disclosed in claim 1 above and in the previous Office Action (paper number 6)

wherein said gathered data includes litigation monitoring of industry litigation, said potential litigation issues being based on said litigation monitoring of industry litigation (Martin; column 9, lines 45-60, column 12, lines 49-63, column 15, lines 10-15), (Heckman; column 21, lines 52-57).

The motivations for combining the respective teachings of Heckman, CPR, Martin are as given in the rejection of claim 1 above, and incorporated herein and in the prior Office Action (paper number 6) and also incorporated herein.

### *Response to Arguments*

11. Applicant's arguments filed 30 July 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 30 July 2003.

(A) At page 9 of the 30 July 2003 response Applicant argues the rejections made under 35 USC §101, and mentions that the Examiner is relying on the "now defunct 'mental steps' doctrine."

In response, it is noted that the Examiner rejection was not based on the 'mental steps' doctrine, or on the fact that the claimed process is NOT useful or tangible. Rather, the basis of the Examiner's rejection was that the recited claims were not directed to a practical application in the technological arts. With regard to this issue, it is noted that Applicant's presently recited claims do not even rise the level of the claims under review by the Federal Circuit in the *State Street Bank* decision, which clearly and explicitly recite a practical application in the technological arts. Note, for example, the format and language of claim 1 in the *State Street Bank* decision, provided hereinbelow:

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1. A data processing system for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:
  - (a) computer processor means [a personal computer including a CPU] for processing data;
  - (b) storage means [a data disk] for storing data on a storage medium;
  - (c) first means [an arithmetic logic circuit configured to prepare the data disk to magnetically store selected data] for initializing the storage medium;
  - (d) second means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases or decreases based on specific input, allocate the results on a percentage basis, and store the output in a separate file] for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds, [sic, funds'] assets and for allocating the percentage share that each fund holds in the portfolio;
  - (e) third means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund;
  - (f) fourth means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund; and
  - (g) fifth means [an arithmetic logic circuit configured to retrieve information from specific files, calculate that information on an aggregate basis and store the output in a separate file] for processing data regarding aggregate year-end income, expenses, and capital gain or loss for the portfolio and each of the funds.

As such, it is respectfully submitted that Applicant's reliance on the *State Street Bank* decision is not persuasive, as Applicant's presently recited claims clearly lack a practical application in the technological arts in a manner consistent with the claims reviewed by the Federal Circuit in their decision.

Moreover, the Examiner is concerned that Applicant apparently ignores the mandate of other court decision that clearly support the Examiner's position. For example, the court in *In re Toma* stated: " 'technological' or 'useful' arts inquiry must focus on whether claimed subject matter, for example, method of operating machine to translate, is statutory, not on whether

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product of claimed subject matter, for example, translated text, is statutory, not on whether prior art that claimed subject matter purports to replace, for example, translation by human mind, is statutory, and not on whether claimed subject matter is presently perceived to be improvement over prior art, for example, whether it 'enhances' operation of machine; this was law prior to *Gottschalk v. Benson*, 175 USPQ 673, and was not changed by *Benson*." (emphasis added) 197 USPQ 852, 853 (CCPA 1978). In *In re Musgrave*, 167 USPQ 280 (CCPA 1970), it was held that "... all that is necessary to make a sequence of operational steps a statutory 'process' within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with Constitutional purpose to promote progress of 'useful arts' ..." (emphasis added).

Further, the lack of "concreteness" as noted in the previous Office Action, is further evidenced by Applicant's remarks on page 9, lines 15-18, which note a scenario in which "one of an alert is generated, a report is generated or no action is taken" demonstrating a situation in which the results cannot be assured (i.e. not repeatable). It is respectfully submitted that the scenario wherein no action is taken reduces the claim to a method that is not concrete, as no alert or report is generated at all.

In sum, it is respectfully submitted that the Examiner's rejection of the claims under 35 USC 101 is indeed proper and should be maintained for at least the reasons given above and the guidance of appropriate case law.

(B) At page 9-10 of the 30 July 2003 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly

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added features in the 30 July 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Heckman, CPR, Martin, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein. In particular, Examiner notes that the recited features of evaluating a level of risk and deciding on or selecting a course of action such as issuing an alert or a report based on the level of risk are taught by the combination of applied references (Heckman; column 14, line 40 to column 16, line 12, column 25, lines 16-60), (Martin; Figure 5, Items 550 and 570, column 9, lines 45-60, column 10, lines 21-27, column 12, lines 49-63, column 15, lines 10-15).

(C) At page 9-10 of the 30 July 2003 response, Applicant argues the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In

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particular, as demonstrated in the rejections of newly amended Claims 1, 7, 10 and 13 and in newly added claim 19 above, the combined cited references of Heckman, CPR, Martin, teach determining whether a report or "pop-up" (reads on an alert) is appropriate by performing an analysis (Heckman; column 25, lines 16-29), issuing an alert or report "[...] as a communication from a legal department to at least one recipient [...]" (Heckman; column 14, line 40 to column 16, line 12, column 25, lines 16-60), and determining a course of action "[...] based on a risk level of said potential litigation issues [...]" (Martin; Figure 5, Items 550 and 570, column 9, lines 45-60, column 10, lines 21-27, column 12, lines 49-63, column 15, lines 10-15), as well as monitoring industry litigation trends (Martin; column 9, lines 45-60, column 12, lines 49-63, column 15, lines 10-15), (Heckman; column 21, lines 52-57).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the



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motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

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In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. **Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:**

(703) 305-7687.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

*NP*

Natalie A. Pass

October 9, 2003

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600